

REMARKS

Claims 5, 11, 18, 19, 21, 22, and 26 are pending and under consideration.
Reconsideration is requested based on the following remarks.

Interview Summary

The Applicants submit the following summary of the telephone interviews that took place July 26 and August 22, 2006 between the undersigned representative of the Applicants and the Examiner.

Telephone Conference:

The Applicants thank the Examiner for the many courtesies extended to the undersigned representative of the Applicants during the telephone interviews that took place July 26 and August 22, 2006.

Among the issues discussed during that interview were the rejection of claims 5, 11, 18, 19, 21, 22, and 26 under 35 U.S.C. § 101, the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility," (hereinafter "Guidelines"). The Examiner averred to instructions from the Office Quality Assurance personnel to reject the claims according to the Guidelines, and particularly pages 21, 22, and 23.

The passages cited in the Guidelines have been reviewed carefully. Nothing in those passages is believed to negate the patentability of the claims, as discussed more fully below. The sections of the Guidelines which appear at pages 21, 22, and 23, rather, pertain to claims that include *excluded* subject matter, such as an abstract idea, a law of nature, or a natural phenomenon, which is not the case here.

Furthermore, the "practical application" to which the Guidelines refer at pages 21, 22, and 23 is one way to render claims that include excluded subject matter patentable. Such a "practical application" is not necessary for claims that do not include excluded subject matter, let alone claims that fall into one of the four categories of statutory subject matter under 35 U.S.C. § 101.

The Applicants reiterate their request for an interview at the Office with the Office Quality Assurance personnel in attendance, following their review of these remarks.

Claim Rejections - 35 U.S.C. § 101:

Claims 5, 11, 18, 19, 21, 22, and 26 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The rejection is traversed. Withdrawal of the rejection is earnestly solicited.

The Office Action asserts at page 3, lines 1 and 2 that:

A review of application 09/921,924 shows the disclosed invention hereof to be an apparatus and method for processing a natural language document.

Indeed, claims 5 and 11 are directed to an “anonymity setting device,” i.e. the apparatus identified in the Office Action, while claims 18, 19, 21, 22, and 26 are directed to a method. Claims 5, 11, 18, 19, 21, 22, and 26 are thus submitted to fit specifically within one or another of the “process,” “machine” or the “manufacture” categories of statutory subject under 35 U.S.C. § 101. As provided therein:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Since all of claims 5, 11, 18, 19, 21, 22, and 26 fall within one of the four stated categories of statutory subject matter, claims 5, 11, 18, 19, 21, 22, and 26 are submitted to be directed to statutory subject matter within the meaning of 35 U.S.C. § 101.

The Office Action asserts further at page 3, lines 3-6 that:

However, it does not disclose specific hardware, specific software, or a combination thereof for performing the claimed functions. No more specific disclosure of the claimed “units”, recited in claims 5 and 11, is set forth, i.e. no computer program, no logic circuits.

To the contrary, Figs. 1A and 1B of the specification, for example, are block diagrams showing a functional structure to support the claimed invention, which are implemented by the program control of a computer device, as described at page 15, lines 22-25, as well as at page 38, lines 4-27, continuing at page 39, lines 1-9.

Furthermore, the described “calculating unit” is submitted to be substantially synonymous with a “calculator,” while the described “processing unit” is submitted to be substantially synonymous with a “processor,” both of which are familiar to those of skill in the art as examples of hardware, software, or combinations thereof.

The Office Action asserts further at page 3, lines 6 and 7 that:

The steps that formed the claimed process are devoid of any limitations to any practical application.

Claims 5 and 11 are directed to an “anonymity setting device,” not a process, as discussed above. Claims 5 and 11, furthermore, are submitted to have the practical application of setting anonymity.

According to the Guidelines, however, an inquiry as to whether a claim has a practical application is only necessary for claims that include *excluded* subject matter, such as an abstract idea, a law of nature, or a natural phenomenon. In particular, as provided in the Guidelines at page 19, lines 1-9:

For claims including such excluded subject matter to be eligible, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (“application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”); *Benson*, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula claim because it “has no substantial practical application”).

Thus, the “practical application,” consideration is meant to determine whether a claim that includes excluded subject matter is *nevertheless* directed to statutory subject matter, since the claim is for a practical application of the excluded matter. There is no assertion in the Office Action that either claims 5 or claim 11 include an abstract idea, a law of nature, or a natural phenomenon in the first place, so requiring them to be directed to a practical application is at least premature, as well as inapposite.

According to the Guidelines, furthermore, not just any practical application will do, rather, the claim must be for a practical application of a § 101 judicial exception. In particular, as provided in the Guidelines at page 19, lines 10 and 11:

To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception.

Thus, the “practical application,” consideration is only meant to apply to claims that include excluded subject matter, and thus fall into one of the § 101 judicial exceptions. To read otherwise would be to read the Guidelines as *requiring* claims to include excluded subject matter, so that they can be salvaged by also reciting a practical application. Since, as discussed above, neither claim 5 nor claim 11 includes excluded subject matter in the first place, there is no further requirement that they be directed to a practical application.

Pages 21, 22, and 23 of the Guidelines continue in the same vein, i.e. the various forms of practical applications listed therein are all meant to see if a claim that includes excluded

subject matter, like an abstract idea, a law of nature, or a natural phenomenon, is nevertheless directed to statutory subject matter, because it *also* recites a practical application of that judicial exception. Since, as discussed above, neither claim 5 nor claim 11 includes excluded subject matter in the first place, nothing at pages 21, 22, and 23 of the Guidelines is believed to apply to either claim 5 or claim 11.

Section (IV)(C)(2)(a) at page 19 of the Guidelines, for example, pertains to finding a practical application by physical transformation. As described at page 20, lines 2-5:

For eligibility analysis, physical transformation “is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application.” *AT&T*, 172 F.3d at 1358-59, 50 USPQ2d at 1452.

Thus, practical application by physical transformation is an example of how a mathematical algorithm [or law of nature], neither of which are recited in claim 5 or claim 11, may bring about a useful application.

Section (IV)(C)(2)(b), similarly, pertains to claims directed to a practical application of the § 101 judicial exception producing a result tied to the physical world that does not preempt the judicial exception. As described at page 20, lines 12-16:

If the claim is directed to a practical application of the § 101 judicial exception producing a result tied to the physical world that does not preempt the judicial exception, then the claim meets the statutory requirement of 35 U.S.C. § 101. If the examiner does not find such a practical application, the examiner has determined that the claim is nonstatutory.

Thus, producing a result tied to the physical world that does not preempt the judicial exception is an example of how a claim directed to a practical application of the § 101 judicial exception can be statutory. Since, however, neither claim 5 nor claim 11 contain any of the three judicial exceptions to § 101 in the first place, they do not need to produce a result tied to the physical world that does not preempt the judicial exception.

Section (IV)(C)(2)(b)(1), similarly, describes how claims can be distinguished from the three § 101 judicial exceptions to patentable subject matter by specifically reciting in the claim the practical application. As described at page 21, lines 2-6:

In addition, when the examiner has reason to believe that the claim is not for a practical application that produces a useful result, the claim should be rejected, thus requiring the applicant to distinguish the claim from the three § 101 judicial exceptions to patentable subject matter by specifically reciting in the claim the practical application.

Since, as discussed above, neither claim 5 nor claim 11 contain any of the three § 101 judicial exceptions to patentable subject matter in the first place, they do not need to be distinguished therefrom.

Section (IV)(C)(2)(b)(2), similarly, describes how a claim must recite more than a § 101 judicial exception. Clearly, this section pertains to claims that include one of the three § 101 judicial exceptions to patentable subject matter, not all claims. As described at page 21, lines 17-23:

However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. *Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”). “[A]n application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection.” *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (emphasis added)

Since, as discussed above, neither claim 5 nor claim 11 contain any of the three § 101 judicial exceptions to patentable subject matter at all, they necessarily recite more than a § 101 judicial exception.

According to the Guidelines, furthermore, USPTO personnel must *first* identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in 35 U.S.C. § 101. In particular, as provided in the Guidelines at page 14, lines 20, 21, and 22, continuing at page 15, lines 1 and 2:

To properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. § 101, USPTO personnel must first identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in section 101 (process, machine, manufacture or composition of matter).

Since claims 5 and 11 fall within at least the “machine” or the “manufacture” categories, claims 5 and 11 are submitted to be directed to statutory subject matter within the meaning of 35 U.S.C. § 101.

Additionally, as provided in the Guidelines, the burden is on the USPTO to set forth a prima facie case of unpatentability. Thus, claims are presumed to belong to one of the four enumerated categories of patentable subject matter recited in 35 U.S.C. § 101 unless the Office is able to show otherwise. In particular, as provided in the Guidelines at page 16, lines 1-4:

The burden is on the USPTO to set forth a prima facie case of unpatentability.

Therefore if the examiner determines that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, the examiner must provide an explanation.

Since the Office Action includes no assertion that claims 5 and 11 do *not* fall within at least the “machine” or the “manufacture” categories, the Office has set forth no prima facie case of unpatentability, and claims 5 and 11 are submitted to be directed to statutory subject matter within the meaning of 35 U.S.C. § 101.

Furthermore, according to the Guidelines, an examiner must ascertain the scope of the claim to determine whether it covers either a § 101 judicial exception or a practical application of a § 101 judicial exception. In particular, as provided in the Guidelines at page 18, lines 6-13:

An examiner must ascertain the scope of the claim to determine whether it covers either a § 101 judicial exception or a practical application of a § 101 judicial exception. The conclusion that a particular claim includes a § 101 judicial exception does not end the inquiry because “[i]t is now commonplace that an application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.” *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (emphasis in original); accord *Flook*, 437 U.S. at 590, 198 USPQ at 197; *Benson*, 409 U.S. at 67, 175 USPQ at 675.).

Since, as discussed above, neither claim 5 nor claim 11 contain any of the three § 101 judicial exceptions to patentable subject matter, i.e an abstract idea, a law of nature, or a natural phenomenon, in the first place, they necessarily recite more than a § 101 judicial exception. Claims 5 and 11 are thus submitted to be directed to statutory subject matter within the meaning of 35 U.S.C. § 101.

Finally, the Office Action asserts at page 3, lines 10 and 11 that:

Claims 5, 11, 18, 19, 21, 22 and 26 reviewed in the light of the specification, simply recite a series of method steps.

To the contrary, claim 5 recites, inter alia a specificity calculating unit, an anonymity setting processing unit, a syntax analyzing means, a person specifying tree extracting means, and a tree structure specificity calculating means, none of which are steps.

Claim 11, similarly, recites, inter alia a specificity calculating unit and an anonymity setting processing unit, neither of which are steps, either.

Claims 18, 19, 21, 22, and 26 are method claims, and are acknowledged to recite a series of method steps. Structure is not necessary for method claims. Claims 18, 19, 21, 22, and 26 are thus submitted to fit specifically within the “process” category of statutory subject

under 35 U.S.C. § 101. Since claims 18, 19, 21, 22, and 26 fall within one of the four stated categories of statutory subject matter, i.e. the "process" category, claims 18, 19, 21, 22, and 26 are submitted to be directed to statutory subject matter within the meaning of 35 U.S.C. § 101, whether they include structure or not.

Claims 5, 11, 18, 19, 21, 22, and 26 are submitted to be allowable. Withdrawal of the rejection of claims 5, 11, 18, 19, 21, 22, and 26 is earnestly solicited.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 5, 11, 18, 19, 21, 22, and 26 are allowable. Allowance of all claims 5, 11, 18, 19, 21, 22, and 26 and of this entire application is therefore respectfully requested.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

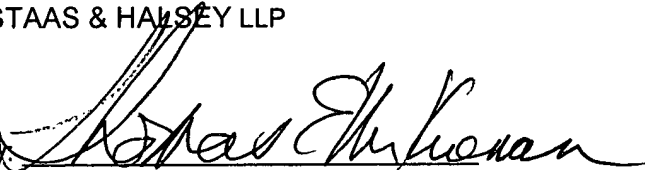
Respectfully submitted,

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